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08/732,408	12/09/1996	JOHANNES REINMULLER	HUBR1099PFFM	7906
7590	02/21/2006		EXAMINER	
FULBRIGHT AND JAWORSKI 666 FIFTH AVE NEW YORK, NY 10103			PELLEGRINO, BRIAN E	
			ART UNIT	PAPER NUMBER
			3738	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 08/732,408
Filing Date: December 09, 1996
Appellant(s): REINMULLER, JOHANNES

FEB 21 2006
Group 3700

James R. Crawford
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/22/05 appealing from the Office action
mailed 3/10/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on 7/26/05 has been entered. Thus claim 157 has been amended and claims 171-174 canceled.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 129-132,135-141,147,149,152-155,160,167-170,175-181 are rejected under 35 U.S.C. 102(e) as being anticipated by Henley (5534023). Fig. 1 shows a medical implant with a plurality of connected strands of material **14** and an outer covering **11**. Henley discloses the covering is a silicone rubber, col. 4, lines 8-9. Henley also discloses the beads inside have extrudate chains **14** that the Examiner is interpreting as "spaghetti-like strands," which are made of silicone, col. 4, lines 30-33. It is inherent that silicone is hydrophobic. Henley discloses the method of using the implant for implantation and it is placed at a soft tissue site, col. 3, lines 60-65. Henley discloses lubricants to reduce friction can also be added, such as swellable ones or a polysaccharide such as dextran, col. 6, lines 22-26. Please note that anything can be considered "wettable". The examiner is interpreting the claimed elements "continuous solid strands" in this way: since all the strands are joined it can be considered to be contiguous along its length (see Fig. 6) and the term "solid" as a phase of matter that is not a gas or liquid. Claims in a pending application should be given their broadest reasonable interpretation. *In re Hyatt* (CAFC) 54 USPQ2d 1664 (2000). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054,1055.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 133,134,158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley '023 in view of Fisher (5496367). Henley '023 is explained as before. However, Henley does not disclose the use of plastic for the strand material. Fisher discloses the use of plastic for structural material enclosed in an implant (col. 3, lines 18-22) and is used to provide structure to the implant, col. 2, line 64. It would have been obvious to one of ordinary skill in the art to substitute materials and use plastic as taught by Fisher in the implant of Henley such that it provides more rigidity or structural firmness to the implant.

Claims 142,144-146,148,150 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley '023 in view of Shimizu (5607590). Henley '023 is explained as before. However, Henley does not disclose the surface is hydrophilized. Shimizu teaches that silicone surfaces can be hydrophilized such that it increases the affinity for living tissue or potential tissue ingrowth, col. 1, lines 49,50,55-60. Shimizu also discloses treatment of the material provides for better tissue compatibility and reduces antigenicity and improves transfixing properties, col. 2,lines 41-43. It would have been obvious to one of ordinary skill in the art to use a hydrophilized surface as taught by Shimizu with the implant of Henley such that the prosthesis is able to be secured within the body and not have shifting, while also improving its biocompatibility.

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Claims 156,157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley '023 in view of Perry et al. (5282857). Henley is explained supra. However, Henley does not disclose using fat or oil as a lubricant. Perry et al. teach that fats or oils in the form of glycerides are used in implants, col. 3, lines 1-4. It would have been obvious to one of ordinary skill in the art to use a fat or oil that wets a surface of the implant for lubrication as taught by Perry with the implant of Henley in order to reduce friction and permit a more natural movement within the shell.

Claim 143,161,162 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henley '023 in view of Taylor (4657553). Henley is explained supra. However, Henley does not disclose the use of polysaccharides or polydimethylsiloxane as the implant material. Taylor teaches that polysaccharides are used in soft tissue implants and can be hydrophilic, col. 1, lines 55-57. Taylor also teaches that polydimethylsiloxane is used in constructing medical implant material, col. 4, lines 37-44. It would have been obvious to one of ordinary skill in the art to use a polysaccharide or polydimethylsiloxane as the implant material as taught by Taylor for the implant of Henley because of the suitability of these materials in medical uses. Polysaccharides are not harmful if leakage does occur.

Claim 159 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henley '023 in view of Shimizu '590 as applied to claim 148 above, and further in view of Fisher '367. Henley as modified by Shimizu is explained supra. However, Henley in view of Shimizu do not disclose plastic as the implant material. Fisher is explained supra. It would have been obvious to one of ordinary skill in the art to use plastic as an implant

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material as taught by Fisher for the implant of Henley as modified by Shimizu in order to provide a little more firmness to the implant's feel.

Claim 163 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henley '023 in view of Fisher '367 as applied to claim 158 above, and further in view of Chapman (4348329). Henley as modified by Fisher is explained supra. However, Henley in view of Fisher do not disclose cuprophane as the implant material. Chapman teaches that polymers or "plastic" used in implants have coatings that are biocompatible, col. 6, lines 32-36,49-54 and cuprophane is one material used (col. 13, lines 9,12). It would have been obvious to one of ordinary skill in the art to use cuprophane as an implant material as taught by Chapman for the implant of Henley as modified by Fisher in order to reduce cell membrane damage.

Claims 164-166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley '023 in view of Ledergerber (EP 322194). Henley is explained supra. However, Henley does not disclose a foam structure in the implant or X-ray medium incorporated in the implant. Ledergerber teaches that foam can be used in the implant, col. 4, lines 8-18. Ledergerber additionally teaches that an x-ray contrast medium can be incorporated into the material, col. 12, lines 53-58. It would have been obvious to one of ordinary skill in the art to use a foam structure or a contrast medium in the implant as taught by Ledergerber with the implant of Henley such that it may be less dense as a result of using foam so it does not feel too heavy for the patient and is easily detected by imaging.

(10) Response to Argument

Applicant argues that Henley does not disclose “spaghetti-like” strands that are solid, but strands that are interrupted by air filled beads or chambers. However, despite Applicant’s comments, it should be noted that Henley’s “beads” are not considered “interrupted” as Applicant contends because Henley describes the “beads” as elongate, strings or chains of interlinked material, col. 4, lines 26,29-31,45-47,53. Also as mentioned above, the Examiner is interpreting the material of Henley’s “spaghetti-like strand” *to be solid* since it is not a liquid or gas. It is noted that Applicant has failed to define what is meant by the term “solid”. Although terms in claims are interpreted in light of the written disclosure, no special definition for “solid” has been set forth in the specification. According to Applicant’s disclosure (page 5, 1st full paragraph) the strands are described as “capillary tubes or tubular form. According to what is known in the art, tubes are considered “hollow”. Applicant’s drawings show what can be construed as “hollow” tubes. Thus the Examiner interprets the term “solid” as a state of matter, which Henley clearly shows the strand of material as. Applicant also argues that Henley does not disclose a “continuous spaghetti-like strand”. Again as mentioned above, Henley discloses the material is contiguous and Fig. 6 clearly shows the strand is clearly continuous. Applicant has failed to even define what is meant by the term “continuous” and thus the Examiner interprets the claim limitation of “continuous” as something that can be connected together. Although terms in claims are interpreted in light of the written disclosure, no special definition for “continuous” has been set forth in the specification. Applicant also argues that the strands of Henley do not consist of

silicone rubber. However, as mentioned above, Henley clearly discloses the strands are made of silicone, col. 4, lines 56,57. In response to Applicant's argument that Henley includes additional structure (air chambers) not required by Applicant's invention, it must be noted that Henley discloses the invention (strands made of silicone) as claimed. The fact that it discloses additional structure not claimed is irrelevant to the issue of patentability. Applicant also argues that Henley does not disclose the device is wettable. The Examiner stated in the rejection anything can be considered "wettable" since Applicant has failed to even define what is meant by the term and no special definition for "wettable" has been set forth in the specification. Applicant also argues that Henley does not disclose using a polysaccharide lubricant, but failed to acknowledge the disclosure the Examiner referred to in the previous office action, col. 6, lines 22-26. Applicant additionally argues Henley does not disclose a plurality of strands. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., individual or separate strands) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant also argues the rejections of Henley in view of the above cited references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

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found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner considers any modification in a material or lubricant to be within the skill of one of ordinary skill in the art. Additionally, it is noted that page 4 (last full paragraph) of Applicant's specification a silicone is defined to be a plastic. However, it should also be noted that Henley's disclosure could encompass the interpretation of plastic meaning silicone, such that Henley could anticipate any of the claims directed to a plastic.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Brian E. Pellegrino

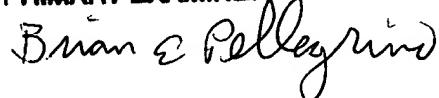
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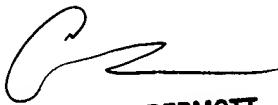
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